

REMARKS

By the present amendment, independent claim 1 has been amended to further clarify the concepts of the present invention. Specifically, the subject matter of dependent claim 3 has been incorporated therein and the binder has been defined as being water soluble. Claim 3 has been cancelled. Entry of these amendments is respectfully requested.

In the Office Action, claim 3 was rejected under the first paragraph of 35 USC § 112 as not being enabled by the specification as filed. In particular, it was asserted that the composition "polyvinyl alcohol-cation monomer graft copolymer" was not enabled since there is no evidence that (a) the material with the disclosed tradename was available at the time the application was filed and that (b) one of ordinary skill in the art would have been able to obtain this material. Reconsideration of this rejection in view of the attached document and the following comments is respectfully requested.

In response to the former (a), attention is directed to the attached Declaration of Mr. Koji Idei, one of the inventors herein. The Declaration of Mr. Idei states that the agents as identified in the specification were available for sale from Hymo Co. Ltd. as of October 18, 2000, the date the subject application was filed.

Further, with respect to the latter (b), the subject specification identifies the material in many of the Examples as "cationic polymer fixing agent (SC-600G2 manufactured by Hymo Co., Ltd.) and the previously submitted materials show that the cationic fixing agents are now available from Hymo Co., Ltd of Japan. It is submitted that one of ordinary skill in the art in this country would be able to obtain these agents without difficulty. Most Japanese companies are capable of transacting business in English. The website of Hymo Co., Ltd. at [www.hymo.co.jp](http://www.hymo.co.jp) can be located without difficulty using a Google search and the website at <http://www.hymo.co.jp/index.html> is partially in the English language.

However, even if this particular company were not capable of conducting business in English at all, it would not take a great deal of effort for any person in the United States to locate another person here who would be capable of communicating with the company in the Japanese language. While obtaining such a person may entail the expenditure of funds, certainly the costs would not be prohibitive and it would not be a difficult endeavor to do so.

For the reasons set forth above, withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1-6 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Koide et al in view of the patent to Yasuda et al and the European patent

publication to Koji et al for the reasons of record. As before in making this rejection, it was asserted that the patent to Koide et al teaches a recording paper with a coating composition as set forth in the claim 1 and with the properties as recited in claim 1. Without specifically so stating, it apparently was acknowledged that the disclosed recording paper does not include a cationic fixing agent as defined in claim 1. Then, apparently reliance was made upon the secondary patent to Yasuda et al for teaches the inclusion of such an agent and also for teaching a cationic polyvinyl alcohol copolymer apparently in reference to the specific subject matter of claim 3. The Koji et al patent publication apparently was relied upon for teaching the additional subject matter of claims 2 and 5. Reconsideration of this rejection in view of the following comments is respectfully requested.

As mentioned above, independent claim 1 has been amended herein to incorporate the subject matter of dependent claim 3 therein. As such, the coating solution contains a diaminostilbene-disulfonic acid derivative (A) as a fluorescent brightening agent, a binder and a polyvinyl alcohol-cation monomer graft polymer (B) as a cationic polymer fixing agent, the mixing ratio A:B in solid coating amount being within the range of 1:6-2:3. In addition, the binder recited in claim 1 has been defined as consisting essentially of a water-soluble binder. It is submitted that the claimed inkjet recording paper as now recited in amended claim 1 is not taught or suggested by the cited patents to Koide et al and Yasuda et al or the European patent publication to Koji et al, whether taken singly on in

combination.

In the last response, it was urged that was that one of ordinary skill in the art would not be motivated to combine the patent teachings in the manner proposed by the examiner. More particularly, it was urged that the portion of the Yasuda et al patent relied upon in the Action (col. 9, lines 36-40) relates to a cationic polymeric substance which functions as a water-proof agent. While it was acknowledged that such may be considered to be basically the same as a cationic fixing agent of the subject invention which does provide water resistance, however one of ordinary skill in the art would not be motivated to use such a substance according to the patent with a water-soluble binder as in the presently claimed ink jet recording sheet. In support thereof, it was stated that the Yasuda et al patent teaches at col. 9, lines 36-39 that the water-proof agent must be water-soluble and further that it is taught that this agent is to be used in conjunction with a water-insoluble binder.

The subject Action responded to this particular argument by asserting that the Yasuda et al patent teaches at column 8, lines 38-39 that an water soluble or water insoluble additional binder may be used. Thus, it was asserted that the binder according to the Yasuda et al patent apparently can be a combination of an additional water soluble binder and the primary water insoluble binder. It is submitted that the above mentioned amendment to claim 1, that is, the recitation in subject claims, among others, that the

binder consists of a water-soluble binder distinguishes the subject claims over the teachings of the cited patent. Thus, it is submitted that one of ordinary skill in the art would not be motivated to use such a substance according to the Yasuda et al patent with a water-soluble binder as in the presently claimed ink jet recording sheet. In addition, applicants previously submitted evidence in the form of a Declaration under 37 CFR § 1.132 which presented experimental evidence regarding the products according to the Koide et al patent which demonstrated unexpected or surprising results for the claimed recording paper relative to the recording paper of the cited Koide et al patent.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1-2 and 4-6 as amended over the cited patent publications are respectfully requested.

Claims 1, 4 and 6 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Miyamoto et al or the patent to Yasuda et al. In making this rejection, it was asserted that the cited patents each teaches a recording paper with a coating composition as set forth in the claim 1 and that it would be obvious to optimize to achieve the properties as recited in claim 1. Reconsideration of this rejection in view of the following comments is respectfully requested.

As stated previously, independent claim 1 has been amended to incorporate the


subject matter of dependent claim 3 has been incorporated therein. Since claim 3 was not rejected herein, it is submitted that this rejection is now moot. Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1-2 and 4-6 as amended over the cited patents are respectfully requested.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

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Enclosure: Declaration